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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,815	08/07/2003	Jay D. Knitter	200209059-1	9770
22879 7590 09/26/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER BIAGINI, CHRISTOPHER D	
			ART UNIT 2142	PAPER NUMBER
			MAIL DATE 09/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/635,815

Applicant(s)

KNITTER, JAY D.

Examiner

Christopher D. Biagini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/16/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

The IDS filed on July 16, 2007 is sufficient is compliant with 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, it has been placed in the application file and reference A5 has been considered.

The drawings filed on July 16, 2007 are sufficient to overcome the objection under 37 CFR 1.84(o). Accordingly, the objection is withdrawn.

The amendment to claim 19 is sufficient to overcome the rejection under 35 USC 101 of claims 19-21. Accordingly, the rejection is withdrawn.

The arguments regarding the rejection under 35 USC 112, second paragraph of claims 6-9, 15-18, and 21 have been fully considered but are not persuasive. Applicant states that "[t]he protocol described in US Patent No. 6,457,066 ('the '066 patent') and the protocol implemented by Apache Axis were included as examples of implementations of SOAP, not as definitions of SOAP." However, the Examiner respectfully submits that no reasonable definition of SOAP exists which encompasses both the protocol described in the '066 patent and the protocol implemented by Apache Axis. As explained in the previous Office Action, the protocols are vaguely related in that

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they are used to access remote objects, but are wholly and fundamentally different in operation.

In effect, Applicant appears to be seeking protection on any protocol which happens to be named "SOAP" or "Simple Object Access Protocol." Although the presence of a trade name in a claim is not, *per se*, improper under 35 USC 112, its meaning must be established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim. See MPEP § 2173.05(u) and § 608.01(v). No such definition is currently of record. Accordingly, the rejection of claims 6-9, 15-18, and 21 under 35 USC 112, second paragraph, is **maintained**.

The amendment to claim 19 is sufficient to overcome the rejection under 35 USC 112, second paragraph of claims 19-21. Accordingly, the rejection is withdrawn.

The arguments with respect to the rejection of claims 1-2, 11, and 22 under 35 USC 102 have been fully considered and deemed persuasive. Accordingly, the rejection is withdrawn.

The arguments with respect to the rejection of claims 1-2, 11, and 22 under 35 USC 102 have been fully considered and deemed persuasive. Accordingly, the rejection is withdrawn.

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The arguments with respect to the rejection of claims 3 and 12 under 35 USC 103 have been fully considered and deemed persuasive. Accordingly, the rejection is withdrawn.

Claim Rejections - 35 USC § 112

First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (a) the breadth of the claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of

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ordinary skill; (e) the level of predictability in the art; (f) the amount of direction provided by the inventor; (g) the existence of working examples; and (h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

As to the breadth of the claims, the currently pending claims in the instant application are broad. Essentially all implementations for using a proxy to examine an execution stack to identify the caller of a network service fall within the scope of the claims. Analysis of this factor in light of all the evidence of record therefore suggests that the amount of experimentation required to make and use the invention is undue.

As to the nature of the invention, there is no relevant evidence of probative value in the record. Analysis of this factor in light of all the evidence of record therefore does not suggest whether the amount of experimentation required to make and use the invention is undue or not undue.

As to the state of the prior art, the very features that Applicant argues distinguish the claims from the prior art are those that are not adequately described. A search of the prior art has not revealed a system as claimed for using a proxy to examine an execution stack to identify the caller of a network service. Analysis of this factor in light of all the evidence of record therefore suggests that the amount of experimentation required to make and use the invention is undue.

As to the level of skill in the art, there is no evidence in the record as to the level of skill in the art. Analysis of this factor in light of all the evidence of record therefore does not suggest whether the amount of experimentation required to make and use the invention is undue or not undue.

As to the level of predictability in the art, the computer arts are generally considered predictable. Analysis of this factor in light of all the evidence of record therefore suggests that the amount of experimentation required to make and use the invention is not undue.

As to the amount of direction provided by the inventor, Applicant's arguments indicate that the distinguishing feature of the claimed invention is the use of a "comparison algorithm" on a client server to identify "an object on the client computer that is invoking the object on [a] data server." However, the specification does not adequately describe how this operation occurs. It is unclear whether the client server examines its own execution stack or the execution stack of the client computer. Examining its own execution stack would be of little benefit. Since the client computer and client server are completely separate machines, as illustrated in Fig. 1, and the execution stack of a system contains only those objects which exist locally in memory, the execution stack of the client server would contain no information regarding which object on the client computer was invoking the object. If the client server is intended to

examine the execution stack of the client computer, it is unclear how this would occur, as there is no direction in the specification as to how the client server is able to examine the execution stack of a remote system.

The specification describes exemplary code for implementing the claimed algorithm, but this code would not be functional in the claimed embodiment. Specifically, and in stark contrast to the claimed embodiment and the embodiment illustrated in Fig. 1, it is noted that *the client executes on the same machine as the comparison algorithm*. Entry into the program occurs at the `main` method on line 2. Subsequently, the program creates a `Client2` object and invokes its `sendSOAPMessage` method. The `sendSOAPMessage` method in turn creates a `Client3` object and invokes its `findSourceOfSOAPMessage` method. The `findSourceOfSOAPMessage` method then creates an `Algorithm` object and invokes its `findSourceOfSOAPMessageCall` method. The execution stack is accessed on line 13 of the `Algorithm` class, but this execution stack is merely the local execution stack shared with the initial `Client` object. In other words, such an algorithm would not be functional in an arrangement where the client and client server are not local objects running on a single machine, but computers separated by a network link.

Furthermore, although Applicant's arguments and amended claim limitations indicate that the algorithm identifies an *object* on the client computer that is invoking the object on the data server, absolutely no provision for doing so appears in the specification. Even assuming, *arguendo*, that the described algorithm is functional in the claimed embodiment, the algorithm only identifies the *class* that invokes the object. In

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object-oriented programming, classes are essentially “blueprints” for creating objects in memory. A class may be instantiated into multiple different objects, each of which share the class’s name. Therefore, the class name returned by the algorithm described on pages 5 and 6 of the specification is insufficient to “identify...an object on the client computer.” This assertion is supported by the document “Re: Finding the caller in java,” which indicates that “[y]ou can’t find out which Object called a certain method unless you use the debugging API.” The Examiner notes that the specification as filed includes no discussion of using the debugging API to identify an object.

Analysis of this factor in light of all the evidence of record therefore suggests that the amount of experimentation required to make and use the invention is undue.

As to the existence of working examples, the specification does not describe a working example. Analysis of this factor in light of all the evidence of record therefore suggests that the amount of experimentation required to make and use the invention is undue.

As to the quantity of experimentation needed, there is no evidence in the record to indicate the quantity of experimentation that one of ordinary skill in the art would need to implement the present invention. Analysis of this factor in light of all the evidence of record therefore does not suggest whether the amount of experimentation required to make and use the invention is undue or not undue.

The majority of factors for which there is evidence suggest that undue experimentation is required. See the discussion of the breadth of the claims, the state of the prior art, and the amount of direction provided by the inventor. The level of predictability in the art suggests that undue experimentation is not required. As to the other factors, the evidence of record is insufficient to establish whether the amount of experimentation is undue or not undue. See the discussion of the nature of the invention, the level of ordinary skill in the art, and the quantity of experimentation needed. After weighing all of the factors and all the evidence of record, **the totality of the evidence suggests that it would require undue experimentation to make and use the claimed invention.**

Furthermore, although a patent need not teach, and preferably omits, what is well known in the art (*In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984)), the corollary to this statement is that a patent should disclose more detail concerning the features that distinguish the claimed invention from the prior art. In this regard, the specification's lack of direction, which is discussed above, appears especially critical.

Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9, 15-18, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of the claims recites a Simple Object Access Protocol (or its abbreviation, SOAP), but it is unclear to which Simple Object Access Protocol the claims are directed. Applicant's specification incorporates by reference U.S. Patent No. 6,457,066 (hereinafter, "the '066 patent"), but also refers to the Apache Axis API (see paragraphs [0003]-[0004]). The Examiner notes that the protocol described in the '066 patent is not the same as that implemented by Apache Axis. The protocol described in the '066 patent is for accessing Microsoft COM Automation objects using MIME-encoded messages (see col. 3, lines 1-64), while the protocol that is implemented by Apache Axis is for accessing W3C SOAP web services using XML messages (see "Introduction" on the Axis home page). The protocols are similar in that they are layered on top of HTTP and are used to access remote objects, but are otherwise entirely different.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The USENET post "Re: (HELP) Advanced Java Question for Java Gurus" shows subclassing the Java `SecurityManager` class in order to obtain access to the `getClassContext` method.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

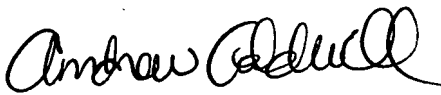
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on M-R 7:30-5, 7:30-4 alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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